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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT PAPER NUMBER

1722

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,024

Applicant(s)

HOLLANDS ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 11 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,10 and 12 is/are rejected.
- 7) ☒ Claim(s) 2,5,6 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/079,556.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to recite that the mold "consists essentially of" dies, which include a "single runner hole" disposed substantially in the center of the upper die. Applicant emphasizes these amendments in distinguishing the prior art applied in the previous Office Action, noting for example that no other holes or openings other than the centrally dispersed runner hole are present in the mold (see Response of 17 July 2006, p. 6, ll. 10-12). Claim 7, however, recites that additional runner holes are provided in the mold. As such, claim 7 is indefinite as it appears to contradict claim 1 (from which it depends) by requiring additional runner holes in the mold, which are precluded by the structure defined in claim 1.

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Swiss Pat. Pub. No. 679 263 (hereinafter "CH '263"). Note the English abstracts of this reference also made of record with this Office Action.

CH '263 discloses a mold structure which includes first and second dies (7 and 8) defining a mold cavity (see Figs. 2 and 3). The dies are separable from one another, and have a wall thickness that is significantly less than one-half the average diameter of the mold cavity (Fig. 2). The dies are also provided with a single runner hole (11) disposed in the center of the upper of the two dies (Fig. 2). CH '263 further notes the dies are made from a of foil material (see Abstract).

The claims of the instant application define an intended use for the claimed mold. Specifically, the mold is recited as being used for manufacturing pellets of hot-melt ink, and thus the runner hole has a size sufficient for the introduction of ink for the manufacture of the pellets in the mold cavity. It

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is well settled, however, that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP 2115. Moreover, a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987); MPEP 2114. In this case, the apparatus disclosed by CH '263 includes all of the structural features of the claimed mold apparatus, and therefore anticipates the apparatus claims of the instant application, regardless of the defined use for making pellets of hot-melt ink.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over CH '263 in view of Syrmis (U.S. Pat. No. 4,455,320).

CH '263 discloses the mold as described above, notably including making the dies out of foil material. CH '263 does not further specify the type of foil. It is known in the art, however, that aluminum foil is a suitable type of foil for the construction of a mold. As an example, Syrmis discloses the use of aluminum foil in the manufacturing a mold structure (cl. 2, ll. 30-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have used aluminum foil for making the mold of CH '263 because this type of foil is known to be suitable construction of such a mold as suggested by Syrmis.

9. Applicant's arguments with respect to claims 1, 3, 4, 7, 10 and 12 have been considered but are moot in view of the new grounds of rejection described above.

10. Claims 9 and 11 are allowed. Claims 2, 5, 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including

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all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a mold as defined in claims 2, 5, 6, 8, 9 or 11. The closest prior art disclosed by CH '263 is described above. CH '263 fails to teach a heating system or heating means to be associated with the dies. Further, given CH '263 purpose of molding chocolate which involves cooling rather than heating, there would appear no reason to include a heating system or heating means with the mold. CH '263 also fails to teach the dies to have a wall thickness of less than 2.0 mm. CH '263 in fact discloses the mold to have a thickness of 10 mm (see cl. 4, ll. 56-58), thus significantly greater than 2.0 mm.

See also the reasons for indicating allowable subject matter in the previous Office Actions.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a). Applicant is

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reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached at (571) 272-1316. The official fax phone number for

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the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
Primary Examiner
A.U. 1722

9-28-6